

match is not affirmed even when said match determination is made for a plurality of times. --

REMARKS

By the present amendment, Applicants amend claims 1-2, and 6-8 to more appropriately define the present invention, and add new claims 9-24 to protect additional aspects thereof. Claims 1-24 are currently pending in the application.

In the Office Action dated November 6, 2002, the Examiner rejected claim 1 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,296,570 to Miyamoto et al. ("Miyamoto"), rejected claims 2-4 under 35 U.S.C. § 103(a) as being unpatentable over Miyamoto in view of U.S. Patent No. 6,149,523 to Yamada et al. ("Yamada"), and rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Miyamoto in view of Yamada, and further in view of U.S. Patent No. 6,241,524 to Aoshima et al. ("Aoshima").

The Examiner objected to claims 6-8 under 37 C.F.R. 1.75(c) as being in improper form due to multiple dependent claims depending from other multiple dependent claims. Applicants have amended the dependency of claims 6-8 to place them in proper dependent form, and therefore respectfully request the Examiner withdraw the 1.75(c) objection to these claims and consider them on their merits.

The Examiner also objected to the drawings under 37 C.F.R. 184(p)(4) because an incorrect reference character was used in Fig. 3. Applicants submit herewith a Request for Approval of Drawing Change providing a proposed drawing addressing the error in Fig. 3. Applicants request the Examiner's consideration of the proposed

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

drawing and will, upon the Examiner's approval, provide a corrected formal drawing. No new matter has been added.

Finally, without explanation, the Examiner refused to consider the documents submitted in the Information Disclosure Statement (IDS) filed August 26, 2002, as indicated by the crossed out entries on the Form PTO 1449. Apparently, the documents were not considered because no separate English language translation or concise statement of relevance was provided with the foreign language documents. However, Applicants submit that "the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of [a] search report or action by [a] foreign office. See M.P.E.P. 609 III.A(3) (8<sup>th</sup> ed. 2001). Since an English language search report was submitted with the IDS, Applicants respectfully request the Examiner proceed to consider the documents cited on Form PTO 1449, and to acknowledge such consideration by the appropriately marking the Form PTO 1449.

Applicants respectfully traverse the §102(e) rejection of claim 1 because the Examiner failed to establish a *prima facie* case of anticipation under §102(e). In order to properly anticipate Applicants' claimed invention under 35 U.S.C. §102(e), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. §2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. §2131 (8<sup>th</sup> ed. 2001), p. 2100-69.

Regarding claim 1, Miyamoto discloses video game system which generates player object image data and message data. The message data is provided to a user describing how to operate a game controller. More specifically, Miyamoto discloses a video game system adapted to supply player-assisting items or advice in the form of a message at proper timing in accordance with a surrounding environment (col. 2, lines 20-24). The message is displayed in a predetermined area on the display (col. 13, lines 5-7; Fig. 12, 31a). A plurality of predetermined messages are stored and prioritized as to their relative importance. The messages include specific information providing a player with direct instructions on how to manipulate the game controller to accomplish a specific task relevant to a game circumstance (col. 13, lines 10-46). Examples of a specific and direct instructions are shown in Fig. 13 (Phrase 4: “REPEL BY ROLLING - TWICE DEPRESS Z OR R”)

Conversely, Miyamoto fails to disclose, as recited in claim 1, at least “outputting a prompt which indirectly teaches a key operation corresponding to a special action of a game . . . said prompt relating to an action other than the special action and suggesting the key operation to the player.” (emphasis added). Specifically, Miyamoto only discloses providing the player with direct instructions on how to use a controller, but does not disclose, at least, “indirectly teach[ing] a key operation” through “suggesting the key operation to the player.”

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Accordingly, Applicants respectfully request the Examiner to withdraw the § 102(e) rejection of claim 1.

Applicants respectfully traverse the §103(a) rejections of claims 2-4 to Miyamoto in view of Yamada because the Examiner failed to establish a *prima facie* case of obviousness under §103(a). In order to maintain a valid §103(a) rejection, each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. §2143.03 (8<sup>th</sup> ed. 2001).) Second, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on Applicant’s disclosure.” (M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).)

Claims 2 and 4, by virtue of their dependency from claim 1, include all of the features recited therein. Accordingly, as presented above for claim 1, Miyamoto fails to teach or suggest at least “outputting a prompt which indirectly teaches a key operation corresponding to a special action of a game . . . said prompt relating to an action other than the special action and suggesting the key operation to the player.”

In this respect, Yamada fails to cure the deficiencies of Miyamoto. Yamada merely teaches a game machine which provides an image synthesis method for synthesizing a game image and determining whether or not an input sequence matches

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

a given standard sequence (col. 1, lines 51-55). Yamada teaches identifying a plurality of buttons and actuators on a game controller with graphic symbols so visual feedback may be provided to a user (col. 2, lines 46-60; Fig. 1B, 41-51). Complex controller sequences which are input are visually presented to the user to determine which input operations are successful and which are failures (col. 5, lines 55-59). Other embodiments differentiate input instructions by assigning different sounds to each controller actuator to aid the user in performing the proper input sequence (col. 6, lines 2-9).

Neither Miyamoto or Yamada, taken either separately or in combination, teach or suggest, as included in claims 2 and 4, at least "outputting a prompt which indirectly teaches a key operation corresponding to a special action of a game . . . said prompt relating to an action other than the special action and suggesting the key operation to the player."

Furthermore, there is no motivation present or suggested in the cited references or the knowledge generally available to one of ordinary skill in the art to modify the teachings of Miyamoto by the teachings of Yamada. Additionally, there would be no reasonable expectation of success to incorporate the teachings of Yamada into Miyamoto since both fail to teach or suggest all of the elements recited in claims 2 and 4.

Accordingly, Applicants respectfully request the Examiner to withdraw the § 103(a) rejection of claims 2 and 4. Claim 3 depends from claim 2 and is allowable for at least the same reasons provided above for allowable claim 2.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Applicants respectfully traverse the §103(a) rejection of claims 5 as being unpatentable over Miyamoto in view Yamada, and further in view of Aoshima, because the Examiner failed to establish a *prima facie* case of obviousness under §103(a).

Claim 5, by virtue of its dependency from claim 1, includes all of the features recited therein. Accordingly, as presented above for claim 1, Miyamoto fails to teach or suggest at least “outputting a prompt which indirectly teaches a key operation corresponding to a special action of a game . . . said prompt relating to an action other than the special action and suggesting the key operation to the player.”

Additionally, as provided above regarding the rejections of claims 2 and 4, Yamada fails to cure the deficiencies of Miyamoto in this respect.

Furthermore, Aoshima fails to cure the deficiencies of Miyamoto and Yamada. Aoshima merely teaches the use of an operational state judging section for judging an operational state from an operation history of the player to select advice data appropriate to the player (col. 2, lines 46-50). This prevents skilled players from being inundated with advice which is meant for beginners (col. 3, lines 1-4).

Neither Miyamoto, Yamada, or Aoshima, either separately or in combination, teach or suggest, as included in claims 1, 2 and 4, at least “outputting a prompt which indirectly teaches a key operation corresponding to a special action of a game . . . said prompt relating to an action other than the special action and suggesting the key operation to the player.”

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Furthermore, there is no motivation present or suggested in the cited references or the knowledge generally available to one of ordinary skill in the art to modify the teachings of Miyamoto by the teachings of Yamada and Aoshima. Additionally, there would be no reasonable expectation of success to incorporate the teachings of Aoshima into Miyamoto and Yamada since both fail to teach or suggest all of the elements recited in claims 1, 2 and 4.

Accordingly, Applicants respectfully request the Examiner to withdraw the § 103(a) rejection of claim 5.

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extension of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRET & DUNNER, L.L.P.

Dated: February 6, 2003

By: Richard V. Burgujian Reg No 24,014  
for Reg. No. 31,744

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com